

II. Remarks

Claims 1-22 are pending. In the requirement for restriction mailed December 11, 2006, the Examiner indicated that the claims are directed to two patently distinct species. Applicant has elected Species II. Notwithstanding this election, it is believed that the restriction requirement set forth by the Examiner is in error. For the reasons set forth hereafter, Applicant respectfully traverses this requirement for an election-of-species.

The Office Action asserts that it is setting forth an election-of-species requirement, where the species are defined as:

- I. Claims 1-12, drawn to a method for manufacturing a semiconductor device comprising generating, supplying, designing and alerting steps
- II. Claim 13-22, drawn to an article fab comprising a design database, a network and a design coordinate engine.

However, this requirement is respectfully traversed, because it is not in proper form. In this regard, Applicant's traverse is not directed to the issue of whether or not these species are patently distinct. Instead, Applicant is respectfully pointing out that the Office Action fails to properly identify any "species" upon which an election-of-species requirement can properly be based. MPEP §806.04(e) emphasizes with italics that:

Claims are definitions of inventions. *Claims are never species . . .*
Species are always the specifically different embodiments.
(Emphasis in original).

The present Office Action attempts to identify two "species", solely by reference to the claims. In essence, the Office Action asserts that certain claims constitute one species and other claims constitute a second species. But this approach is specifically prohibited by MPEP §806.04, which emphasizes that "*Claims are never species*". This improper approach also causes the Office Action to have internal inconsistencies. For example, the Office Action specifies which claims go with which species, but then instructs Applicants to provide "a listing of all claims readable" on the elected species, or in other words a listing of all claims readable on the claims

identified by the Examiner. This makes no sense (and the reason is that the Office Action does not actually identify any true "species" in the first place, because species "*are always the specifically different embodiments*", rather than groups of claims). Official PTO policy specifies that, in the vast majority of patent applications, the proper way to identify different species is by identifying different drawing figures (or by identifying different examples in the case of a chemical invention). More specifically, MPEP §809.02(a) explains that, in a proper election-of-species requirement:

The species are preferably identified as the species of figures 1, 2, and 3 or [in a chemical case] the species of examples I, II, and III, respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. If the species *cannot be conveniently identified*, the claims may be grouped in accordance with the species to which they are restricted. (Emphasis in original).

In other words, if it is possible to do so, the Examiner must identify species by figure numbers. In the rare event that it is simply not possible to identify species by figure numbers, then and only then, the Examiner may identify the species by mechanical means, particular material, or other distinguishing characteristic. And in the extremely rare event that species "*cannot be conveniently identified*" in any of these various different ways, then and only then the Examiner may group claims (but even then it must be remembered that "*Claims are never species*" and that the claims must be grouped "in accordance with the species", as opposed to using the claims to define the species).

As a practical matter, it is an extremely rare situation where an Examiner is able to carry the burden of showing that species "*cannot be conveniently identified*" in any of the various different ways preferred by MPEP §809.02(a), such that the Examiner can resort to grouping claims. In the present Office Action, the Examiner has not carried the burden of demonstrating that species "*cannot be conveniently identified*" in any of the various different ways preferred by the PTO. Accordingly, the Examiner was not entitled to resort to grouping claims. The Office Action therefore fails to properly identify any species upon which an election-of-species

requirement could properly be based. The purported election-of-species requirement is thus inherently defective, and it is respectfully submitted that it must be withdrawn.

The PTO requires that an election be made even if the restriction is shown to be improper. Accordingly, Applicant has elected Species II.

Applicant requests withdrawal of the restriction requirement. Also, in light of the Examiner's indication that all outstanding rejections have been withdrawn, Applicant requests timely issuance of a Notice of Allowance for claims 1-22.

Respectfully submitted,


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